

## REMARKS

Claims 1-22 are currently pending in the present application. Claim 1 has been amended as set forth above. The Applicants respectfully submit that the claims define patentable subject matter.

Claim 1 stands rejected under 35 U.S.C. 112, second paragraph, as being indefinite with respect to the phrase “with certain stacks being associated with certain user actions.” Claim 1 has been amended per the Examiner’s suggestion.

Claims 1-22 stand rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6,278,449 (Sugiarto) in view of United States Patent No. 6,430,624 (Jamtgaard) and United States Patent No. 5,481,710 (Keane). The Applicants respectfully traverse this rejection, at least for the reason discussed below.

### **I. The Combination Of Sugiarto, Jamtgaard, And Keane Does Not Render The Pending Claims Of The Present Application Unpatentable**

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure (MPEP) states the following:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art.

*See* MPEP MPEP § 2142. Additionally, if a *prima facie* case of obviousness is not established, the Applicants are under no obligation to submit evidence of nonobviousness.

The examiner bears the initial burden of factually supporting any

*prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

*See id.*

**A. The Combination Does Not Teach Each And Every Limitation Recited In The Claims**

Sugiarto relates to a “system and method for designating and retrieving information over the internet.” Sugiarto at Abstract. In particular, Sugiarto relates to “the customizing of information for retrieval over a computer network.” *Id.* at column 1, lines 8-10. Through the use of a computer, “each system user may generate any number of configuration files.” *Id.* at column 4, lines 15-17. “Each of these configuration files specifies what information the user would like to retrieve and how the retrieved information is to be formatted.” *Id.* at column 4, lines 17-19.

The Office Action admits that “Sugiarto does not teach generating XSLT from the generated chains and thus generating the transform rules in part from the XSLT.” December 14, 2004 Office Action at page 3. The Office Action also admits that “Sugiarto does not teach wherein the user actions [are] recorded on two stacks and with certain stacks being associated with certain user actions.” *See id.* Because Sugiarto does not teach “wherein the user actions are recorded on two stacks,” as the Office Action admits, it cannot, by definition, teach or suggest, “using the at least two stacks as the basis for supporting the user actions.”

The Applicants respectfully submit that Sugiarto also does not teach, nor suggest, “recording user actions for arranging the elements on the source page and the template page.” Instead, Sugiarto merely saves portions of websites onto a particular screen such that a user can configure a home screen that will display information from websites of interest. For example, Sugiarto states the following:

Thus, in this manner, a user may select various portions of one or more websites to be included in the target screen 570.... Finally, a user may save an edited configuration file by selecting save button 525, may exit the configuration screen and return to personal administration page 205a by selecting done button 530, and may obtain help by selecting help button 414.

Sugiarto at column 6, lines 22-33. As noted above, Sugiarto discloses a system in which a user can configure a customized, personalized screen that includes relevant portions of websites of interest. Sugiarto, however, does not teach, nor suggest, “recording user actions for arranging the elements on the source page and the template page.” In general, the combination of Sugiarto , Jamtgaard, and Keane does not teach, nor suggest, this limitation. Thus, at least for this reason, the claims of the present application should be in condition for allowance.

The Office Action cites column 5, lines 61-63 of Sugiarto as support for “generating the set of transform rules for the source page according to the source page URL.” *See* December 14, 2004 Office Action at page 3. The cited portion of Sugiarto recites the following:

[A] user enters a website address in a URL portion 515, and then selects the submit button in order to access the website for use.

*See* Sugiarto at column 5, lines 61-63. This passage, however, merely discloses a way of gaining access to a website. That is, as clearly noted above, a user may type in a URL address to gain access to a particular website.

Sugiarto goes on to state the following:

This request is then transmitted from desktop computer system 9, through internet network 4 to system server 2 as shown in FIG. 1. System server 2 then retransmits this request back to internet network 4, and accesses the requested web page. In addition to

identifying a web page at URL portion 515, a user may select a particular web page from bookmark section 550.

*Id.* at column 5, line 63 to column 6, line 3. In short, Sugiarto merely discloses a method of gaining access to a webpage, namely, typing in a URL address. Sugiarto, however, does not teach, nor suggest, “generating the set of transform rules for the source page according to the source page URL...” The combination cited by the Examiner does not teach, nor suggest, this limitation. Thus, at least for this reason, the claims of the present application should be in condition for allowance.

The Office Action cites Jamtgaard column 2, lines 12-17 to overcome Sugiarto’s lack of “generating XSLT from the generated chains and thus generating the transform rules in part from the XSLT.” The cited passage of Jamtgaard states the following:

Comparable languages, such as Extensible Markup Language (XML), a software language designed especially for Web documents, have become much more mature and permit re-formatting of HTML or XML web pages on-the-fly to formats that individual devices can utilize.

Jamtgaard, column 2, lines 12-17. This passage merely states that XML permits formatting of HTML or XML web pages to different formats. It does not, however, teach or suggest “generating the set of transform rules for the source page according to... the XSLT.” Further, as noted above, the Office Action admits that “Sugiarto does not teach generating XSLT from the generated chains and thus generating the transform rules in part from the XSLT.” December 14, 2004 Office Action at page 3. The Applicants respectfully submit that neither Sugiarto, nor Jamtgaard, teach or suggest “generating the set of transform rules for the source page according to... the XSLT,” as recited in claim 1 of the present application. Thus, at least for this reason,

the Applicants respectfully submit that the claims of the present application should be in condition for allowance.

**B. One Having Ordinary Skill In The Art Would Not Be Motivated To Combine The References**

“A prior art references **must** be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” MPEP at 2141.02. The Applicants respectfully submit that the attempt to pick and choose isolated elements from Jamtgaard and Keane and shoehorn them into Sugiarto ignores the references in their entireties and is therefore improper. There simply is no suggestion in these references to combine them to arrive at the invention recited in the claims of the present application. For example, there simply is no teaching or suggestion in Sugiarto to combine it with Keane to arrive at “recording user actions onto at least two stacks,” and “using the at least two stacks as the basis for supporting the user actions.” Even if one assumed that the combination did teach the limitations recited in the claims, there simply is no motivation to combine these references found within these references.

“In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is **not** whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” MPEP at 2141.02. The law is well settled that “obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so.” *ACS Hospital Systems, Inc. v. Montfiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929 (Fed. Cir. 1984). It is not permissible to pick and choose among the individual elements of assorted prior art references to re-create the claimed invention, but rather “some teaching or suggestion in the references to support their use in the particular claimed combination” is needed. *Symbol*

*Technologies, Inc. v. Opticon, Inc.* 935 F.2d 1569, 1576, 19 USPQ2d 1241 (Fed. Cir. 1991).

In *Ex parte Hiyamazi*, the Board of Patent Appeals and Interferences reversed a rejection based on a combination of references, stating, in part:

Under 35 USC § 103, where the Examiner has relied upon the teachings of several references, the test is whether or not the reference viewed individually and collectively would have suggested the claimed invention to the person possessing ordinary skill in the art. Note *In re Kaslow*, 707 F.2d 1366, 107 USPQ 1089 (Fed.Cir. 1983). It is to be noted, however, that citing references which merely indicate the isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed references would have been obvious. That is to say, there should be something in the prior art or a convincing line of reasoning in the answer suggesting the desirability of combining the claimed invention. Note *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed.Cir. 1986).

*Ex parte Hiyamazi*, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Interf. 1988).

In combining Sugiarto, Jamtgaard, and Keane, the Office Action has merely picked and chosen among isolated, individual elements of separate references to re-create the Applicants' claimed invention. There is no teaching or suggestion in these references to support their use in the particular claimed combination. The proposed combination represents "the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed.Cir. 1983). Thus, at least for these reasons, the Applicants respectfully submit that the claims of the present application should be in condition for allowance.

## **II. Traversal Of Perceived Assertion Of Official Notice**

The Office Action states the following:

[C]laims 16-22 would have been obvious to one of ordinary skill in the art at the time of the invention by what was notoriously well known in the art as keyboard shortcuts such as copy, paste, and cut (i.e. basic word processor functionality such as Microsoft Word 98, which encompassed the equivalent to the drag and drop functionality).

December 14, 2004 Office Action at page 6. However, the Office Action does not cite references that are relevant to the particular claim limitations recited in claims 16-22.

This statement in the Office Action, because of the manner in which it is worded, could be interpreted as the Examiner asserting Official Notice of the subject of the statement. If the Examiner is asserting Official Notice that the subject of the statement is common knowledge, the Applicants respectfully traverse the Examiner's assertion as further set forth below. Alternatively, if the Examiner's assertion is based on the personal knowledge of the Examiner, then under MPEP § 2144.03(C) and 37 C.F.R. § 1.104(d)(2), the Examiner's assertion must be supported by an affidavit from the Examiner.

According to MPEP § 2144.03(A), Official Notice, without supporting references, should only be asserted when the subjects asserted to be common knowledge are "capable of instant and unquestionable demonstration as being well-known." That is, the subjects asserted must be of "notorious character" under MPEP § 2144.03(A).

The Applicants, however, respectfully submit that the subject matter of the Examiner's perceived assertion of Official Notice is not well-known in the art as evidenced by the searched and cited prior art. The Applicants respectfully submit that the Examiner has performed "a

thorough search of the prior art,” as part of the Examiner’s obligation in examining the present application under MPEP § 904.02.

Additionally, the Applicants respectfully submit that the Examiner’s searched and cited references found during the Examiner’s thorough and detailed search of the prior art are indicative of the knowledge commonly held in the art. However, in the Examiner’s thorough and detailed search of the relevant prior art, none of the prior art taught or suggested the subject matter of the Examiner’s perceived assertion of Official Notice. That is, the Examiner’s thorough and detailed search of the prior art has failed to yield any mention of the teachings that the Examiner is asserting as widely known in the art. The Applicants respectfully submit that if the subject matter of the Examiner’s perceived assertion of Official Notice had been of “notorious character” and “capable of instant and unquestionable demonstration as being well-known” under MPEP § 2144.03(A), then the subject matter would have appeared to the Examiner during the Examiner’s thorough and detailed search of the prior art.

If the Examiner had found any teaching of relevant subject matter, the Examiner would have been obligated to list the references teaching the relevant subject matter and make a rejection. Consequently, the Applicants respectfully submit that the prior art does not teach the subject matter of the Examiner’s perceived assertion of Official Notice and respectfully traverses the Examiner’s perceived assertion of Official Notice.

The Applicants specifically challenge the Examiner’s perceived assertion of Official Notice with regard to claims 16-22, namely the following:

1. One user action including a keystroke for moving the source element to an absolute x, y position.
2. One user action including a keystroke for deleting the source element.



3. One user action including a keystroke for replacing the target element with the source element.

4. One user action including a keystroke for changing the attributes of the source element.

5. One user action including a keystroke for replacing the value of the source element with a new value.

6. One user action including a keystroke for inserting the source element just after the start tag of the target element.

7. One user action including a keystroke for inserting the source element just before the end tag of the target element.

As stated above, the Applicants respectfully traverse the Examiner's perceived assertion of Official Notice and submit that the subject matter is not of such "notorious character" that it is "capable of instant and unquestionable demonstration as being well-known." Under MPEP 2144.03, the Examiner is now obligated to provide a reference(s) in support of the assertion of Official Notice if the Examiner intends to maintain any rejection based on the assertion of Official Notice. Additionally, the Applicants respectfully request the Examiner reconsider the assertion of Official Notice and provide to the Applicants any basis for the Examiner's assertion of Official Notice. If the Examiner has any questions, the Examiner is invited and encouraged to contact the Applicants at the number below for further discussion.

### **III. Conclusion**

In view of the foregoing, it is respectfully submitted that pending claims of the present application define allowable subject matter. The Applicants respectfully request reconsideration of the claim rejections. Should anything remain in order to place the present application in condition for allowance, the Examiner is kindly invited to contact the undersigned at the

telephone number listed below. Please charge any additional fees or credit overpayment to Applicants' Deposit Account 13-0017.

Respectfully submitted,

Date: March 9, 2005

By: \_\_\_\_\_

Joseph M. Butscher  
Reg. No. 48,326  
Attorney for Applicants

McANDREWS, HELD & MALLOY, LTD.  
500 West Madison Street, 34th Floor  
Chicago, Illinois 60661  
Telephone: (312) 775-8000  
Facsimile: (312) 775 - 8100